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DA 2736

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Jay Paul White

Application Serial No.: 09/338,744

Filing Date: June 23, 1999

Title: GLOBAL POSITIONING SYSTEMS APPLICATIONS

Art Unit: 2736

Docket No.: 16-647

Examiner: Lee, B.

Watts Hoffmann Co., L.P.A.
1100 Superior Avenue, Suite 1750
Cleveland, OH 4414-2518

RECEIVED

FEB 09 2005

Technology Center 2600

Mail Stop: Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION UNDER 37 C.F.R. § 1.181 (a) TO WITHDRAWAL
HOLDING OF ABANDONMENT**

Dear Sir:

Petitioner and assignee, Symbol Technologies Inc. ("Petitioner"), respectfully requests that the holding of abandonment of U.S. Patent Application No. 09/338,744 (the '744 application") be withdrawn and the '744 application be reinstated as a pending application. A Notice of Abandonment was issued in the '744 application on November 30, 2004. The abandonment of the '744 application apparently was due to the failure of the Applicant to take any action in response to a decision of the Board of Patent Appeals and Interferences. However, the Applicant's failure to respond to the Board's decision was a result of the attorney of record not receiving the Decision due to error on part of the Patent Office. Since the issuing of the Notice of Abandonment was due to an error on the part of the Patent Office, no fee is believed to be required for this petition. However, in the event that a fee is required, the Patent Office is authorized to deduct any required fees from Deposit Account No. 23-0630.

I hereby certify that this paper is being deposited today with the U.S. Postal Service as 1st Class Mail addressed to the Assistant Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450
on 02/09/2005
By [Signature]

Facts

On or about April of 2004 Petitioner requested that Watts Hoffmann Co., L.P.A. (hereinafter "Watts") take over representation of certain pending patent applications filed by another law firm on behalf of Petitioner. Upon receipt of certain files corresponding to applications pending before the Patent and Trademark Office, Watts entered the necessary information for each application into its docketing system. In particular, the information for pending US Application No. 09/338,744 was entered. A printout of the entered information is attached as Exhibit 1. As a matter of procedure at Watts, when correspondence is received in a pending application, data is entered into the docketing system noting necessary due dates for any responses. In the case of the '744 application, there were no necessary due dates to enter into the docketing system as the Petitioner was waiting for a decision from the Board on an appeal filed by the law firm that filed the application on behalf of Petitioner.

On May 6, 2004 a Revocation and Power of Attorney was filed in '744 application revoking the power of the previous representative and appointing Watts as the power of attorney. A copy of the filed Revocation and Power of Attorney is attached as Exhibit 2. Exhibit 3 is a copy of the return postcard indicating that the Patent Office received the Revocation and Power of Attorney on May 10, 2004. On November 30, 2004, a Notice of Abandonment (Exhibit 4) was issued by the Patent Office stating that the '744 application was abandoned because the period for seeking court review of the decision from the Board had expired. According to the Notice of Abandonment, the Board's decision was issued on July 30, 2004. The Board's decision was never received by Watts. As indicated on the Notice of Abandonment, the correspondence address for the '744 application is still that of the previous representative. Watts became aware of the Notice of Abandonment referencing the Board's decision on or about December 7, 2004 and initiated the present petition. Upon being told of the Notice of Abandonment, the undersigned carefully reviewed the file jacket and the docketing system, neither of which indicate that a decision from the Board or a Notice of Abandonment was received by Watts.

Remarks

Petitioner hereby petitions to have the holding of abandonment of the '744 application withdrawn. The petitioner's current representative, Watts, did not receive the decision from the Board. As the facts indicate, Watts filed a Revocation and Power of Attorney appointing them as the Petitioner's representative on May 6, 2004. The Notice of Abandonment was sent on November 30, 2004 to the Petitioner's prior representative. The Notice of Abandonment states that the application went abandoned for failure of the Applicant to seek court review of the Board's decision of July 30, 2004. Once the undersigned received notice of the abandonment, an inspection of Watts' file for the '744 application and docket system was conducted. No evidence of a Board decision or Notice of Abandonment was discovered. Further, the Notice of Abandonment is addressed to the Petitioner's prior representative and was in fact received by the prior representative as indicated by the "RECEIVED" stamp on the front page (See Exhibit 4).

The Patent Office erred in sending any correspondence to the prior representative subsequent to receipt of the Revocation and Power of Attorney. The Patent Office had ample time (over two months) to change the correspondence address from the time the Revocation and Power of Attorney was filed to the date the Board decision was issued. Because the Petitioner's current representative was the appointed representative at the time the Board decision was issued and did not receive the decision from the Board, under Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971), a withdrawal of the abandonment of the '744 application is clearly in order. See MPEP 711.03(c).

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Petitioner respectfully request that the Notice of Abandonment be withdrawn and the decision from the Board be issued to Petitioner's current representative (Watts) setting an appropriate time for the Applicant to take any necessary actions.

Respectfully submitted,

Date: _____

Michael A. Miller
Reg. No.: 50,732
Phone: 216-241-67003
Fax: 216-241-8151

16-647

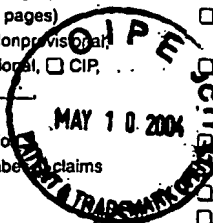
| FILE NO. | TITLE | TYPE | STATUS | COUNTRY | SERIAL NO. | FILING DATE |
|----------|-------------------------------|------|--------|---------|------------|-------------|
| 16-647 | GLOBAL POSITIONING SYSTEMS... | P | P | US | 09/338744 | 06-23-1999 |

Report Completed On 01-26-2005 at 10:15:01

EXHIBIT 1

BEST AVAILABLE COPY

| PATENT APPLICATION | | Attorney Docket No.: <u>40-647</u> |
|--|--|------------------------------------|
| Applicant(s): <u>Dr. Paul White</u> | | Client: <u>2858</u> |
| Title: <u>Global Positioning System Application</u> | | |
| Serial No. <u>09/338,744</u> | Filed <u>06/28/99</u> | Patent No.: _____ |
| Mailing Date: <u>5/10/01</u> | | Initials: <u>20</u> |
| Receipt is hereby acknowledged of the following: | | |
| <input type="checkbox"/> Transmittal (____ pages) | <input type="checkbox"/> Assignment(s) (____ pages) | |
| <input type="checkbox"/> Provisional Application for Patent Cover Sheet | <input type="checkbox"/> Assignment Cover Sheet(s) (____ pages) | |
| <input type="checkbox"/> Request for Filing a Patent Application under 37 CFR 1.53 (b) (____ pages) | <input type="checkbox"/> Small Entity Statement (____ pages) | |
| <input type="checkbox"/> Request for Filing a Patent Application under 37 CFR 1.53 (d) (____ pages) | <input type="checkbox"/> _____ Number of Priority Document(s) | |
| <input type="checkbox"/> Patent Application (____ total pages) | <input type="checkbox"/> Response to Notice to File Missing Parts (____ pages) | |
| <input type="checkbox"/> Provisional, <input type="checkbox"/> New Nonprovisional | <input type="checkbox"/> Copy of Notice to File Missing Parts Form PTO-1533 | |
| <input type="checkbox"/> Continuation, <input type="checkbox"/> Divisional, <input type="checkbox"/> CIP | <input type="checkbox"/> Information Disclosure Statement (____ pages) | |
| <input type="checkbox"/> PCT, <input type="checkbox"/> _____ | <input type="checkbox"/> PTO Form 1449 (____ pages) | |
| ____ cover page | <input type="checkbox"/> _____ Number of Documents | |
| ____ pages of specification | <input type="checkbox"/> Petition for a _____ Month Extension of Time | |
| ____ pages of _____ number of claims | <input type="checkbox"/> Preliminary Amendment (____ pages) | |
| ____ pages of abstract | <input type="checkbox"/> Amendment (____ pages) | |
| <input type="checkbox"/> Drawings (____ sheets) | <input type="checkbox"/> Notice of Appeal (____ pages) | |
| <input type="checkbox"/> Declaration(s) with Power of Attorney (____ pages) | <input type="checkbox"/> Appeal Brief in Triplicate (____ pages each) | |
| <input type="checkbox"/> Check(s) in Amount of \$ _____ | <input type="checkbox"/> Issue Fee Transmittal PTOL-85B & Copy | |
| <input type="checkbox"/> _____ | <input type="checkbox"/> Maintenance Fee Transmittal (____ pages) | |
| <input type="checkbox"/> _____ | <input type="checkbox"/> Request for Continued Examination | |
| <input checked="" type="checkbox"/> <u>Power of Attorney</u> | | |
| <input type="checkbox"/> _____ | | |
| <input type="checkbox"/> _____ | | |



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www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/338,744 | 06/23/1999 | JAY PAUL WHITE | 04873/056002 | 1778 |
| 26161 | 7590 | 11/30/2004 | EXAMINER | |
| FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110 | | | LEE, BENJAMIN C | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2632 | |

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DEC 02 2004

FISH & RICHARDSON, P.C.
BOSTON OFFICE

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

GRL

Please forward:

| |
|-------------------------------|
| transferred |
| Received by Practice Systems |
| CRS |
| Received by Billing Secretary |
| Initials: |

RECEIVED

FEB 09 2005

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| | | | |
|------------------------------|-----------------|-----------------|--|
| Notice of Abandonment | Application No. | Applicant(s) | |
| | 09/338,744 | WHITE, JAY PAUL | |
| | Examiner | Art Unit | |
| | Benjamin C. Lee | 2632 | |


- The MAILING DATE of this communication appears on the cover sheet with the correspondence address-

This application is abandoned in view of:

1. ☐ Applicant's failure to timely file a proper reply to the Office letter mailed on _____.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.

(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☐ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.

The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☒ The decision by the Board of Patent Appeals and Interference rendered on 30 July 2004 and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:


 Benjamin C. Lee
 Primary Examiner
 Art Unit: 2632

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.